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09/915,801	07/26/2001	Thomas A. Soulanille	9623/338	1960

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EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 07/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/915,801

Applicant(s)

SOULANILLE ET AL.

Examiner

Haythim J. Alaubaidi

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-17 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 5, 8-9
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to application No. 09/915,801 filed on July 26, 2001.
  2. The Examiner acknowledges the claim for priority of application No. 09/322,677 (currently patented with an issue date of July 31, 2001) with the earlier filing date of May 28, 1999.
  3. Claims 1, 7 and 10, are rejected under 35 U.S.C. 112, second paragraph.
  4. Claims 1-17 are presented for examination of which Claims 1, 7, 10, 13 and 14 are independent claims.
  5. Claims 1-5 and 7-17, are rejected under 35 U.S.C. 103(a).
- Claim 6 is objected to as being dependent upon a rejected base claim.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 1, 7 and 10, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The above-mentioned Claims stating the limitation of "arranging the identified search listings for display in a random order" which the Examiner can't find the support for it in the Specification. In fact a support in the Specification can be found for sorting the results in order according to the amount of the bid (see Specification of the instant Application Page 27, Lines 11-17; also Figure No. 7

displaying the result listings as sorted and ordered according to the highest amount bid from top to bottom.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5 and 7-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan J. Buck (U.S. Patent No. 6,078,866 and Buck hereinafter) in view of Yeon-Seung Ryu (U.S. Patent No. 6,377,961 and Ryu hereinafter).

Regarding Claims 1 and 13, Buck discloses:

receiving a search request from a searcher (Figure No. 5; see also Col 5, Lines 52-54)

in a database of search listings (Col 4, Lines 2-3, i.e. *having a site listings database containing a plurality of site listings*) each search listing being associated with an advertiser<sup>1</sup> (Col 4, Lines 3-4, i.e. *each of which is provided by a site listing subscriber*) and including at least one search term (Col 4, Lines 4-5, i.e. *and includes a title or description of the content of the respective site*; see also Col 4, Lines 30-35, i.e. *The denominated-value approach to rankings may also be used in conjunction with the index search method or the category search method. In the first*

case, an index search of the listing service's database is performed using keywords, and the resulting listings found are ranked according to their subscription fee values) and a bid amount modifiably (Col 4, Lines 19-20, i.e. and can modify their rankings by raising or lowering their subscription fees) bid by the advertiser (the subscriber) (Col 4, Lines 6-8, i.e. and a denominated value to be paid by the subscriber associated with the site listing; see also Col 4, Lines 45-47, i.e. such as a highest fee paid; see also Col 9, Lines 55-65, i.e. and a denominated value bid by the subscriber for the site listing), identifying search listings having search terms generating a match with the search request (index / keyword searching)<sup>2</sup> (Col 5, Lines 52-54, i.e. a user ABE@netA can query an index search service (indicated by the numeral 20 in the figure), and receives targeted listings in a search report)

selecting according to bid amount identified search listings (Col 4, Lines 32-35, i.e. In the first case, an index search of the listing service's database is performed using keywords (this would read on the previous limitation), and the resulting listings found are ranked according to their subscription fee values) for display to the searcher (Col 6, Lines 17-22, i.e. Positive results are sorted and displayed by denominated value (dollar amounts paid for subscription fees) in block 3),,,,

communicating the search result list to the searcher (Figure No. 5)

Buck reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the feature of (selecting a predetermined number of result listings for display). However, Given the intended broad application of Buck figures No. 4A and 4B would indicate so indirectly; in addition, selecting a predetermined number of

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<sup>1</sup> The advertiser is being interpreted as the subscriber.

<sup>2</sup> Index searching using keywords or search terms are know in the art and mentioned in the summary of Buck reference, see Col 1, Lines 44-47, i.e. "**The index or Boolean search allows the user to enter one or more keywords, which may be qualified by Boolean operators, in order to locate relevant content by matching the keywords with those appearing in the content.**"

listings for display would be inherent; the display of most computers can only display or output a limited number of records (listings results) especially when using an Internet browser that is known in the art. This feature would have been obvious and it does not rise to the level of patentability as a browser can only display an output of a limited number of records (predetermined).

Buck reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the feature of arranging the identified search listings for display in a random order. However Ryu teaches displaying the search results in a random order (Col 2, Lines 5-8, i.e. *Instead of sorting the search results by geographical location, one of many conventional methods is used. One method is to display the search results in random order, see also Col 3, Line 65 through Col 4, Line 3, i.e. FIG. 4 illustrates a display of the search results that are generated using the keyword "Java" on the Lycos.COPYRGT. web search engine. One method of displaying the uniform resource locators, that represent the servers containing the appropriate information, shows a random displaying method*).

Given the intended broad application of the Buck system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Buck with the teachings of Ryu to increase the flexibility of the search engine, as adding more flexibility or more options and features, such as the random display of the results to a search engine will increase its popularity, in turn this will attract more users and more advertisers or web page owners who normally are the financial supporters to the search engine web site.

Regarding Claims 2 and 3, Buck discloses changing the random order upon subsequent receipt of the search request (Col 7, Lines 41-43, see i.e. next) and also

periodically (Col 7, Lines 40-41, i.e. *Once payment is validated, the system will automatically update the database and begin listing the URLs in the appropriate categories and rankings in response to new search queries. Because the positions of the listings are based on objective criteria, i.e., the denominated value paid by the subscriber, the subscriber can pay an increment to improve a listing's position relative to other URLs within the service, and have the new position immediately reflected in the search database).*

Regarding Claim 4 and 5, Buck discloses detecting a change in the content and detecting an increased bid amount (Col 7, Lines 16-28, i.e. *With the use of the URL POSITION MANAGER.TM. interface, a URL may be automatically added to the Internet search service database. By logging in with the correct identification, a subscriber may add one or more URLs to the database, update the subscriber's account including any of the listed URL addresses, titles, descriptions, keywords, IDs, and subscription fees. The subscriber can use the REMOVE link to remove a URL, the UPDATE link to change their URL information, and the MODIFY USER ACCOUNT link to change their password, email address and personal information. A subscriber may also control the URLs active or inactive listing status, in case the URL is under construction and needs to hide its visibility until completion).*

Regarding Claim 7, the limitation of this claim has been noted in the rejected claim 1, above. In addition, Buck teaches weighted according to the bid amount associated with each respective identified search listing (Figure No. 2B, Element No. 43; see also Figure No. 4B, Element 14a).

Regarding Claims 8 and 11, the Examiner is interpreting these Claims in two ways;

- The first would be the user is selecting one of the listings that was displayed to him/her as a result of a search (Col 6, Lines 29-32, i.e. *If the user selects a site listed in 3a, the user is transferred to the web site location as indicated at block 5*);

- The other possibility is that the advertiser or the subscriber is selecting one of the listings they listed before in the database in order to change some information associated with the listing, such as the URL location or content in the site or the bid amount in order to increase or decrease the ranking of the site (Col 7, Lines 16-26, i.e. *With the use of the URL POSITION MANAGER.TM. interface, a URL may be automatically added to the Internet search service database. By logging in with the correct identification, a subscriber may add one or more URLs to the database, update the subscriber's account including any of the listed URL addresses, titles, descriptions, keywords, IDs, and subscription fees. The subscriber can use the REMOVE link to remove a URL, the UPDATE link to change their URL information, and the MODIFY USER ACCOUNT link to change their password, email address and personal information*).

Regarding Claims 9 and 12, the limitation of this claim has been noted in the rejected claim 1, above. In addition, Buck teaches the influence of bid amount being controlled by one or more predetermined parameters (Col 8, Lines 24-27)<sup>3</sup>.

Regarding Claim 10, the limitation of this claim has been noted in the rejected claim 1, above. In addition, Buck teaches weighted according to the bid rank associated with each respective identified search listing (Figure No. 2B, Element No. 42).

Regarding Claim 14, the limitation of this claim has been noted in the rejected claims 1, 5 and 6, above. It is therefore rejected as set forth above.



Regarding Claim 15 and 16, the limitations of these claims are similar in scope to the rejected claims 1, 5 and 6 above. In addition Buck discloses determining a bid N cents higher (Col 7, Lines 36-47, i.e. increment to the subscription fee; see also Col 8, Lines 24-27; see also Col 8, Lines 18-22, i.e. *The subscription fee may be zero to any amount in U.S. \$10 increments*).

Regarding Claim 17, Buck discloses updating the data defining the bid amount (Col 7, Lines 45-48, i.e. *immediately reflected in the search database*).

### **Allowable Subject Matter**

10. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is the Examiner's statement of reasons for the indication of allowable subject matter:

Regarding Claim 6, Applicant's particular methods in the environment of listing search results is applying an algorithm to the probability of displaying a respective search listing of the identified search listings in a particular location in the search result list to reduce the randomness of the ordering of the search result list record in combination with the other limitations of the claims, was not disclosed by, would not have been obvious over, nor would have been fairly suggested by the prior art of record or that encountered in searching of the prior art.

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<sup>3</sup> The bid amount is influenced by the ranking parameter as increasing it or decreasing it will change the

***Other Prior Art Made of Record***

12. a. Ryan et al. (U.S. Patent No. 6,421,675) discloses a search engine; and  
b. Goldhaber et al. (U.S. Patent No. 5,855,008) discloses an attention brokerage.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

***Points of Contact***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (703) 305-1950. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Art Unit: 2171

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 746-7238 or (703) 746-7239 or (703) 746-7240.

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, 6<sup>th</sup> Floor Receptionist, Arlington, Virginia. 22202.

*Haythim J. Alaubaidi*

  
WAYNE AMSBURY  
PRIMARY PATENT EXAMINER

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